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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/811,011 | 03/15/2001 | Ulhas S. Warrier | 42390P10851 | 8561 |

8791     7590     12/29/2006
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| EXAMINER |
|---|
| DENNISON, JERRY B |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2143 | |

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|---|---|---|
| 3 MONTHS | 12/29/2006 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

| | | Application No. | Applicant(s) |
|---|---|---|---|
| ***Office Action Summary*** | | 09/811,011 | WARRIER ET AL. |
| | | Examiner | Art Unit | |
| | | J. Bret Dennison | 2143 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on <u>3 October 2006</u>.

2a)☐ This action is **FINAL**.  2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1,2,4,6-24 and 28-35* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4,6-24 and 28-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All  b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

## DETAILED ACTION

1.     This Action is in response to the Amendment for Application Number 09/811,011

received on 3 October 2006.

2.     Claims 1, 2, 4, 6-24, 28-35 are presented for examination.

### *Claim Interpretation*

3.     Claim 17 includes the limitation, "to allow network traffic sent to the external

address to be received by the network driver."

4.     Claim 21 includes the limitation, "to allow said application program to embed the

WAN address within the network traffic data."

Any language that suggests or makes optional but does not require steps to be

performed or does not limit a claim to a particular structure does not limit the scope of a

claim or claim limitation. See MPEP 2106, section II, subsection C for specific

examples.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of
> making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the
> art to which it pertains, or with which it is most nearly connected, to make and use the same and shall
> set forth the best mode contemplated by the inventor of carrying out his invention.

5.     Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with

the enablement requirement.  The claim(s) contains subject matter which was not

described in the specification in such a way as to enable one skilled in the art to which it

pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 includes the limitation "sending the packet from the first machine to the second

machine <u>via the network configuration server</u>..." Examiner is unable to locate this

functionality in the instant specification.  It is understood by Examiner that the first

machine is in a private network behind a NAT access point (Figure 4 of the instant

application), and the second machine is external to the private network.  This would

require the communication to be via the NAT access point and not the server that is

"external to the private network."


The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly
claiming the subject matter which the applicant regards as his invention.

Claims 1-37 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.


6.      Claim 1 recites the limitation, "without breaking a protocol utilized for

communication between the first and second machines." Claim 1 then recites the

limitation, "sending the packet from the first machine to the second machine via the

network configuration server based on at least in part on the network configuration data

and the destination address".

It is unclear how the redirection takes place from the server to the second

machine.  Since the network configuration data and the destination address are

embedded in the <u>data portion</u> of a packet, the packet would have to be <u>decapsulated</u> in

order for the server to determine where to send the packet.  If the packet layers are

never "broken" (i.e. without breaking a protocol), the destination address is never shown

to the server. Therefore, it is unclear to Examiner how such functionality is performed

"without breaking a protocol" since decapsulation would have to take place for the

server to determine the address. It is unclear to Examiner how the redirection takes

place in the server.

7.    Claim 1 includes the limitation "sending the packet from the first machine to the

second machine via the network configuration server..." It is unclear to Examiner how

the first machine sends the packet through the network configuration server and not a

NAT access point since the first machine has a private network address that is "subject

to NAT."

8.    Claim 1 includes "receiving network configuration data that is not subject to

NAT." The scope of this limitation is unclear. Does it mean that the packet(s)

containing the network configuration data that are received do not need to be translated

as they pass through a NAT access point to the first machine? Does it mean the

configuration data itself, when used by the first machine, does not need to be translated

when passed through a NAT access point? Examiner is also unclear as to why it

matters that the network configuration data is not subject to NAT if the data is simply

used only in the data portion of a packet. Therefore, the network configuration data is

simply being used as data. Examiner strongly suggests, in addition to clarifying the

above issues, to use language other than "subject to NAT" as it is unclear what this

language means. Using such language also makes unclear whether such subjection to

NAT is required, therefore raising the issue of whether such limitation has weight.

9.      Claim 1 includes receiving network configuration data from an external server,

embedding the network configuration data in a data portion of a packet, and sending the

packet to a second machine via the server based at least in part on the network

configuration data and the destination address.

It is unclear what the point is of the server sending the configuration data to the

first machine in the first place if all the first machine does is send it directly back to the

server. The phrase "based at least in part on the network configuration data and the

destination address" does not explain how the configuration data is used or why it would

be based on the configuration data to send the configuration data in the data portion no

less. The phrase is unclear as to how the sending is based on the destination address

since the destination address is in the data portion of the packet. The claim does not

say it is in the header of the packet, and it is therefore unclear as to how to base the

sending on the destination address. There does not appear to be any association

between the network configuration data and the second machine. In regards to the

claimed invention, Examiner does not see a reason to have the configuration data since

it has no functional interrelationship with anything else in the claim.

10.     Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete

for omitting essential steps, such omission amounting to a gap between the steps. See

MPEP § 2172.01. The omitted steps are: The claim does not explain the format of the packet other than what is included in the data payload. There is no step of how the packet is addressed. There is no step including actual network address translation. There is no explanation as to how the packet is sent to the second machine via the server without breaking a protocol. There is also no step as to how the configuration data is used, other than sending it in a packet.

11.     Claim 2 recites the limitation, "for receiving network traffic sent to the network address." It is unclear to examiner what is receiving the network traffic.

12.     Claim 6 includes method steps, however, it is unclear where these method steps are performed. There is no functional interrelationship between the limitations of the claim. Claim 6 includes the limitation, "receiving a request for a first address of a first machine on the first network." It is unclear to Examiner what receives the request. Claim 6 includes the limitation, "allocating a second address from a server on the second network." It is unclear to Examiner what is allocating the address. Claim 6 includes the limitation, "providing the second network address in response to the request." ." It is unclear to Examiner what is providing the second network address.

13.     Claim 6 includes the limitation, "using the second network address in the payload of the packet to provide a network configuration for a communications exchange." It is unclear to Examiner how using a network address provides a network configuration.

14.    Claim 6 recites the limitation, "using the second network address in the payload

of the packet to provide a network configuration for a communications exchange." It is

unclear as to what is using the second network address, and it is also unclear who it is

being provided to.


15.    Claim 17 includes method steps, however, it is unclear where these method

steps are performed. Claim 17 recites the limitation, "allocating an external address on

an external network." It is unclear what is performing this step.


16.    Claim 17 recites the limitation, "providing the external address to the network

driver of the first machine using a payload portion of a data packet." It is unclear to

Examiner as to what is providing the external address. It is also unclear to Examiner

how the payload portion is used.


17.    Claim 21 includes method steps, however, it is unclear where these method

steps are performed. Claim 21 includes the limitation, "providing layer based network

services..." It is unclear to Examiner as to what is providing these layer-based services.

Claim 21 includes the limitation "executing an application program". It is unclear to

Examiner as to what is executing the application program. Claim 21 includes the

limitation, "providing a WAN address to said application program." It is unclear to

Examiner what is providing the WAN address.

18.     Claim 28 includes an apparatus performing a process steps.  However, certain

limitations of the claim are performed by other devices.  For example the fifth limitation

reads "performing network address translation (NAT) on the packet by the access point

of the packet origin."  It is unclear to Examiner

19.     The amendment filed is insufficient to overcome the *Claim Rejections - 35 USC*

*§ 103.* The rejections are maintained and cited as stated below.

20.     Claims 1, 2, 4, 6-24, 28-35 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Zhang et al. (U.S. Patent Number 6,381,646) in view of Molitor (U.S.

Patent Number 6,661,799).

21.     Zhang and Molitor were applied for claims' rejection, cited in the previous Office

Action, which are applicable, hereby incorporated by references.

### Response to Arguments

Applicant's arguments and amendments filed on 10/03/2006 have been carefully

considered but they are not deemed fully persuasive.

Since the claims are still replete with claim objections and 112 rejections,

Examiner cannot reasonably define the scope of the invention.  Therefore, Applicant's

arguments are noted, however Examiner maintains the views previously provided.  The

rejection issued in the Final Office Action mailed 06/10/2005 remains applicable for

rejecting the claims as they are currently presented, and is therefore incorporated by reference.

It is noted that the Applicant has made no attempt to show why each and every amendment made to the claims have any sort of patentable novelty or advantage. Applicant makes general arguments that the prior art does not disclose certain limitations. Examiner is not persuaded by arguments that simply state that the prior art does not disclose a limitation without an explanation of why the art does not disclose the limitation.

MPEP 714.04 states:

"In the consideration of claims in an amended case where no attempt is made to point out the patentable novelty, the claims should _not_ be allowed. See 37 CFR 1.111 and MPEP 714.02."

Therefore, the case is not in condition for allowance.

It is the Examiner's position that Applicant has not yet submitted claims drawn to limitations, which define the operation and apparatus of Applicant's disclosed invention in a manner, which distinguishes over the prior art.

Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response and reiterates the need for the Applicant to more clearly and distinctly define the claimed invention.

## *Conclusion*

**Examiner's Note:** Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Bret Dennison whose telephone number is (571) 272-3910. The examiner can normally be reached on M-F 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

J. B. D.
Patent Examiner
Art Unit 2143

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